

III. REMARKS**Status of the Claims**

Claims 32-45 remain under consideration.

Summary of the Office Action

Claims 32-38, 40, and 42-45 stand rejected under 35USC103(a) on the basis of the cited reference Johansson, U.S. Patent No. 5,913,163. The Examiner is respectfully requested to reconsider her rejection in view of the following remarks. Claims 39 and 41 are allowed.

The Invention

A mobile telephone having full capability of communication with a network in a well known manner is also equipped with a local communication module connected to generate a bidirectional local wireless communication link for transmission and reception of communications with an accessory, such as a head set, user interface, or the like, which is adapted to be supported on the person of said user. The local communications link uses time division multiple access with frequency hopping or code controlled multiple access with individual pseudorandom binary sequencing to avoid interference with said radio telephone network communication. The accessory is designed to communicate only over the local communications link with the local communication module of the radio telephone.

Discussion of the Cited References

The Examiner again relies solely on the reference Johansson to support the rejection based on obviousness. The current rejection repeats the prior rejection. Applicant submits that

there is no basis for the use of time division multiple access with frequency hopping or code controlled multiple access with individual pseudorandom binary sequencing to avoid interference in closed local communication system between a cellular telephone and its accessories. Such technology was only considered in the most complex of communication systems. There was no incentive to use such technology in short distance, communications between components that are held in close proximity on the user. The examiner admits that the cited reference fails to disclose such use, but states that time division multiple access with frequency hopping or code controlled multiple access with individual pseudorandom binary sequencing is well known. Based on this statement the Examiner concludes that:

"It would have been obvious to one of ordinary skill in the art to modify Johansson to a system which uses time division multiple access with frequency hopping or code controlled multiple access with individual pseudorandom binary sequencing to avoid interference....."

Applicant submits that there is nothing to support the Examiner's conclusion. The Examiner has apparently reached this conclusion solely on the basis of her own knowledge. This does not constitute prima facie obviousness and this is the main issue remaining in this application. The Manual of Patent Examining Procedure states:

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious

at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

and further:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

Since there is no apparent support for the Examiner's conclusions, the applicant is at a loss to effectively attack the basis of these conclusions. If such conclusions are based on the Examiner's personal knowledge, then Applicants request an affidavit under 37C.F.R., section 1.104 d(2) detailing the Examiner's reasoning.

Applicant submits that the Examiner has failed to present *prima facie* obviousness. The fact remains that, for the reasons stated in the previous response by Applicant and incorporated herein by reference, the proposed combination even if accomplished would not render the claimed invention obvious.

The cited reference describes a system in which multiple communication devices are linked together in a local area communication system. Each of the devices is linked to the

"LACS" by a local interface module that is capable of transforming a non-local communication signal into a local transmission signal. The purpose of this system is to allow a subscriber to more freely roam between private and public systems, for example cellular and cordless systems which use different protocols. (see column 1, lines 35-40). It is also a purpose of the system of Johansson to provide a headset capable of communicating on a single protocol with both a cordless system and with a mobile station (see column 2, lines 44-47).

In support of the rejection, the Examiner states that Johansson discloses a radio telephone (810) comprising a transceiver (830) and a controller (860), and a first remote unit (220) having a transceiver (830) and a controller (860).

A close review of the cited reference reveals, that the reference 810 of Johansson relates to a wireless headset which can communicate with a local interface module 905-A, - 905-E via a local communication link. The wireless headset is not a radio telephone as in the subject application.

The headset is one of the local communication devices of the cited reference. These devices can be connected with a mobile station, a directly connectable home base station associated with a PSTN, a serial computer port connector, an electronic data terminal or a cordless phone base unit. The local communication device of Johansson is described as follows in column 3, lines:

"Each of the locally-positioned communication devices is also provided with a corresponding local interface module wherein the local interface module is capable of receiving an incoming communication signal and transforming it into a local transport signal suitable for local transmission in accordance with at least one preselected common protocol."

This indicates that each of the units connected within the local

network is capable of receiving signals from external sources only through its associated local interface module. With its local interface module it is a self sufficient device for operation on both a cellular and a cordless system.

The claims of this application are directed to a mobile telephone having accessories operationally connected though a wireless communication link using cellular protocols. The mobile phone is the controller for a limited communication link, the range of which is the immediate vicinity of the user. The system of this invention is simple. It does not include a cordless network controller and other devices which are interconnected through the local interface modules of the myriad local communication devices of the cited reference.

The accessories (remote units) of the subject mobile telephone of this invention communicate only with the mobile telephone over the local communication link which is generated and controlled by the mobile telephone. The remote units of this application are not the same, therefore as the local communication devices of the cited reference. The remote units of this application do not communicate, like the headset cited by the Examiner, in both local and external systems.

This difference is illustrated by the different ways in which the PSTM and cellular calls are handled in steps 1005/1020, see column 10, lines 20-55. None of these decisions arise in the system of the subject application.

Applicant submits therefore that the teaching of the cited reference Johansson has more significant deficiencies than are indicated by the Examiner. The Examiner's official notice of the TDMA and spread spectrum techniques does not remedy these

deficiencies.

Applicant submits that the modification of the teachings of Johansson, in order to obtain the invention, as described in the amended claims submitted herein, would not have been obvious to one skilled in the art. There is no indication that such a modification would be desirable.

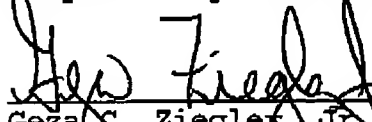
The use of a system designed to communicate between multiple devices in a cordless system and a cellular system is far too complex and expensive to be used for communicating between a mobile telephone and its accessories, all of which are located on the person of the user.

The above remarks apply equally to the rejection as applied to all of the claims.

In view of the remarks stated above, Applicant submits that all of the claims under consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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